

Atty. Dkt. No. 071344-0306

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Hein et al.
Title: TRANSGENIC PLANTS
EXPRESSING ASSEMBLED
SECRETORY ANTIBODIES
Appl. No.: 09/491,322
Filing Date: 01/25/2000
Examiner: C. Collins
Art Unit: 1638

CERTIFICATE OF FACSIMILE TRANSMISSION I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Alexandria, Virginia on the date below.
<u>Germaine Sarda</u> (Printed Name)
<u><i>Germaine Sarda</i></u> (Signature)
<u>April 6, 2004</u> (Date of Deposit)

TERMINAL DISCLAIMER FOR U.S. PATENT No. 5,959,177

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

Your Petitioner, The Scripps Research Institute, having its principal place of business at 10550 N. Torrey Pines Road, TPC8, La Jolla, California 92037 hereinafter represents that it is the owner of the entire right, title, and interest in and to U.S. Patent Application Serial No. 09/491,322, filed 01/25/2000, which is a divisional of serial no. 09/200,657, filed 11/25/98 (pending), which is a continuation of U.S. Patent Application No. 08/642,406, filed 05/03/1996, which issued as U.S. Patent No. 5,959,177 on 09/28/1999, continuation-in-part of U.S. application Ser. No. 07/971,951, filed Nov. 5, 1992 now U.S. Pat. No. 5,639,947, which is a continuation of U.S. Ser. No. 07/591,823, filed Oct. 2, 1990 (now U.S. Pat. No. 5,202,422), which is a continuation-in-part of U.S. Ser. No. 07/427,765, filed Oct. 27, 1989 (abandoned). Interest in U.S. Patent Application Serial No. 09/491,322 is evidenced by virtue of an Assignment in U.S. Patent no. 5,959,177 (information printed from the USPTO website, a copy of which is attached hereto as APPENDIX A) and recorded on 7/15/96 at real/frame

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008034/0773 and by virtue of an assignment in U.S. Patent No. 5,202,422 (information printed from the USPTO website, a copy of which is attached hereto as APPENDIX B) and recorded on 1/10/92 at reel/frame 005967/0324.

Your Petitioner, The Scripps Research Institute, also hereinafter represents that it is the owner of the entire right, title, and interest in and to U.S. Patent No. 5,959,177 by virtue of the aforementioned Assignment in U.S. Patent no. 5,959,177 (information printed from the USPTO website, a copy of which is attached hereto as APPENDIX A) and recorded on 7/15/96 at reel/frame 008034/0773 and by virtue of an obligation to assign. U.S. Patent No. 5,959,177 lists as inventors Mich B. Hein, Andrew Hiatt, and Julian K-C Ma. Hein and Hiatt assigned their rights in the patent to The Scripps Research Institute which assignment is recorded on 01/24/2000 at reel/frame 010590/0528 as already noted. Julian Ma signed a confidentiality and invention agreement dated November 7, 1991 agreeing to assign inventions to The Scripps Research Institute. This agreement, which relates to the inventions that are claimed in U.S. Patent No. 5,959,177, is attached as APPENDIX C. Applicant has requested of Julian Ma on several occasions to comply with his obligation under the agreement and assign his rights in the U.S. Patent No. 5,959,177 to The Scripps Research Institute. However, Julian Ma has refused all such requests despite the signed obligation. Thus, it is Applicant's contention that it is the owner of the entire right, title, and interest in and to U.S. Patent No. 5,959,177 by virtue of the aforementioned assignment from Hein and Hiatt and by virtue of the agreement to assign executed by Ma.

Your Petitioner, The Scripps Research Institute, hereby disclaims the terminal part of the term of any patent granted on the above identified patent application which would extend beyond the full statutory term, as shortened by any terminal disclaimer, of U.S. Patent 5,959,177, and hereby agrees that any patent so granted on the above identified patent application shall be enforceable only for and during such period that the legal title to U.S. Patent 5,959,177 shall be the same as the legal title to any patent granted on the above identified patent application, this

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agreement to run with any patent granted on the above identified patent application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioner does not disclaim any terminal part of any patent granted on the above identified patent application, prior to the full statutory term of U.S. Patent 5,959,177 as defined in 35 U.S.C. §§154-156 and 173, in the event that U.S. Patent 5,959,177 expires for failure to pay a maintenance fee, is held unenforceable or is found invalid in a final judgment by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321(a), has all claims canceled by a reexamination certificate or as a result of an interference proceeding, or is otherwise not deemed to provide the rights conveyed by 35 USC §154, prior to the full statutory term of U.S. Patent 5,959,177 as defined in 35 USC §§154-156 and 173, except for the separation of legal title stated above. Further, Petitioner does not disclaim any terminal part of a patent granted on the above identified patent application that would extend beyond the present termination of U.S. Patent 5,959,177, in the event that such present term is extended by virtue of compliance with the conditions for term extension of any present or future patent term extension provisions of the patent law, including but not limited to 35 U.S.C. §§155, 155A or 156, and without waiving Petitioner's right to extend the term of a patent granted on the above identified patent application to the extent provided by law.

The undersigned, being the Attorney of Record for the above identified patent application, and duly authorized to act on behalf of Petitioner, certifies that the Patent Office reference to recorded assignments attached as APPENDIX A and APPENDIX B is, to the best of his knowledge and belief, grants legal title to both the instant patent application and to U.S. Patent 5,959,177 in the name of The Scripps Research Institute. The undersigned declares that all statements made herein of their own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such

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willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

Respectfully submitted,

Date April 6, 2004

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